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In re Donohue**U.S. Court of Appeals Federal Circuit
226 USPQ 619**

Decided July 3, 1985

No. 85-868

Headnotes**PATENTS****1. Practice and procedure in Patent and Trademark Office -- Prosecution -- Applications for patent
(§ 110.0916)**

Patent Office properly declined to make formal res judicata rejection of patent application that, by including affidavit not submitted in earlier-rejected application, presented new issue of material fact.

2. Patentability/Validity -- Anticipation -- Prior publication (§ 115.0705)

Disclosure of claimed invention in printed publication will not suffice as prior art if it was not enabling, but invention disclosed in publication need not actually have been made in order to satisfy enablement requirement.

3. Patentability/Validity -- Anticipation -- Prior art (§ 115.0703)

Anticipation rejection was proper based on additional references which were not relied upon for suggestion or motivation to combine teachings to meet claim limitations, but were rather used to show that claimed subject matter, as disclosed in single reference that discloses every element claimed, was in public's possession.

Particular patents -- Acids

Donohue, Tetramethylbiphenylcarboxylic Acids and Derivatives Thereof, rejection of claims 1, 2, 5, 6, 7, 25, and 28, affirmed.

Case History and Disposition:

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of John A. Donohue, Serial No. 263,900, filed May 15, 1981, division of Serial No. 60,909, filed July 26, 1979, continuation-in-part of Serial No. 622,249, filed Oct. 15, 1975, continuation-in-part of Serial No. 517,506, filed Oct. 24, 1974. From rejection of claims 1, 5, 6, 7, 25, and 28, applicant appeals. Affirmed.

See also 207 USPQ 196.

Attorneys:

William Magidson, Chicago, Ill., for appellant.

Harris A. Pitlick, Associate Solicitor (Joseph F. Nakamura, Solicitor, and John W. Dewhirst, Associate Solicitor, on the brief) for Patent Office.

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Judge:

Before Markey, Chief Judge, Baldwin, Circuit Judge, and Miller, *Senior Circuit Judge.

Opinion Text**Opinion By:**

Miller, Senior Circuit Judge.

This is an appeal from the decision of the U.S. Patent and Trademark Office ("PTO") Board of Appeals ("Board") sustaining the final rejection of appellant's claims 1, 2, 5, 6, 7, 25, and 28. We affirm.

BACKGROUND

The subject matter of this appeal was previously before this court's predecessor in *In re Donohue*, 632 F.2d 123, 207 USPQ 196 (CCPA 1980) ("*Donohue I*"). 2 There is no need to discuss the details of that opinion; however, a summary of the pertinent facts is appropriate for a full understanding of the issues before us.

The present invention relates to 2,2',6,6'-tetramethylbiphenyl-4,4'-dicarboxylic acid compounds which are suitable for producing polymers used to form shaped objects, such as film, fibers, or molded parts. Claim 1, which is the sole independent claim on appeal, is illustrative:

2,2',6,6'-tetramethylbiphenyl-4,4'-dicarboxylic acid compound comprising said acid, an acyl halide derivative thereof, or a simple ester thereof.

The PTO has rejected all the appealed claims under 35 U.S.C. § 102(b) "as anticipated by Nomura [et al.], optionally in view of Lincoln and Walker [et al.]."

Nomura et al. ("Nomura") 3 discloses twelve 2,2',6,6'-tetramethylbiphenyls ("TMBP") which are 4,4'-disubstituted with NH₂, NMe₂, OH, OMe, Cl, Br, I, CO₂H, CO₂Me, CN, NO₂, or H substituents. Methods of preparing all these compounds, except those disubstituted with CO₂H or CO₂Me, are set forth in Nomura.

Nomura's disclosure of how to make 4,4'-dinitrile (or dicyano) TMBP is particularly significant, because Lincoln 4 and Wagner et al. ("Wagner") 5 teach, generally, the preparation of carboxylic acids from nitriles by hydrolysis.

In *Donohue I*, a majority of the Court of Customs and Patent Appeals ("CCPA") affirmed the PTO's rejection of appealed claims 1, 5, 6, and 7 6 under 35 U.S.C. § 102(b). *Id.* at 127, 207 USPQ at 200. The basis for the

rejection was, as it is here, Nomura with reference to Lincoln and Wagner. *Id.* at 126, 207 USPQ at 199. A minority of the CCPA voted to reverse the PTO's decision, because they concluded it was uncertain from the text of Nomura that the dicarboxylic acid TMBP and dimethyl ester TMBP were ever prepared. *Id.* at 129, 207 USPQ at 201. Accordingly, Nomura's disclosure was, in the minority's view, no more than a mere naming of the claimed compounds which is insufficient to constitute an enabling disclosure. *Id.* at 129, 207 USPQ at 201. After *Donohue I*, the presently-appealed application was filed. During prosecution before the PTO, appellant submitted an affidavit under 37 C.F.R. § 1.132 executed by Dr. Ellis K. Fields ("Fields affidavit"). In this affidavit, Dr. Fields states that he wrote to Dr. Yoshito Takeuchi, one of the authors of Nomura, to ask whether the disclosed dicarboxylic acid TMBP or dimethyl ester TMBP compounds were ever synthesized, as indicated in Nomura. Dr. Takeuchi responded by stating that these compounds were not synthesized, and Dr. Fields submitted his affidavit to that effect. Despite the Fields affidavit, the examiner finally rejected the claims, and an appeal to the board was filed. The board affirmed the rejection of the claims on the grounds stated *supra*, holding that it was bound by *Donohue I*. As to the Fields affidavit, the board held that whether the authors of Nomura actually prepared the claimed compounds is not "material or relevant"; rather, the key factor in evaluating the adequacy of a reference's disclosure

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was deemed to be whether that disclosure would have been enabling, and the board determined that the CCPA had decided that question with respect to Nomura.

ANALYSIS

[1] Appellant has made a record different from that in *Donohue I* by submitting the Fields affidavit. This new record presents a new issue of patentability with respect to whether the previously sustained anticipation rejection can still be maintained. In view of this new issue, the PTO properly declined to make a formal *res judicata* rejection and addressed the question of whether the Fields affidavit overcomes the rejection of the claims based on Nomura. See *In re Ackermann*, 444 F.2d 1172, 1176, 170 USPQ 340, 343 (CCPA 1971); *In re Russell*, 439 F.2d 1228, 1230, 169 USPQ 426, 48 (CCPA 1971); *In re Herr*, 377 F.2d 610, 611, 153 USPQ 548, 549 (CCPA 1967).

Appellant argues that the Fields affidavit, which states that the authors of Nomura did not make the disclosed dicarboxylic acid TMBP and dimethyl ester TMBP compounds, overcomes the PTO's rejection. It is urged that *Donohue I* and *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978), require, *inter alia*, that a 35 U.S.C. § 102(b) rejection based on a primary reference disclosing a claimed compound in conjunction with one or more references which teach how to make that compound, should be sustained only if the claimed compound was actually made. We disagree.

[2] It is well settled that prior art under 35 U.S.C. § 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. 7 In re Sasse, 629 F.2d 675, 681, 207 USPQ 107, 111 (CCPA 1980); *In re Samour*, 571 F.2d at 562, 197 USPQ at 4; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 64, 651-52, 223 USPQ 1168, 1173 (Fed. Cir. 1984). Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention. See *In re LeGrice*, 301 F.2d at 939, 133 USPQ at 373-74.

Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. *In re Borst*, 345 F.2d 851, 855, 45 USPQ 554, 557 (CCPA 1965), *cert. denied*, 382 U.S. 973, 148 USPQ 771 (1966.) It is not, however, necessary that an invention disclosed in a publication shall have actually been made in order to satisfy the enablement requirement.

In re Wiggins, 488 F.2d 538, 179 USPQ 421 (CCPA 1973) and *In re Sheppard*, 339 F.2d 238, 144 USPQ 42 (CCPA 1964), do not support a contrary view. In those cases, the references were deemed insufficient, because they stated that attempts to prepare the claimed compounds were unsuccessful. Such failures by those skilled in the art (having possession of the information disclosed by the publication) are strong evidence that the disclosure of the publication was nonenabling. By contrast, the fact that the author of a publication did not attempt to make his disclosed invention does not indicate one way or the other whether the publication would have been enabling.

Although *In re Samour* and *Donohue I* mention that the claimed invention in each case was apparently

produced in conjunction with the anticipatory reference, this is a far cry from proclaiming that such production is required to meet the enablement requirement. *In re Samour*, in fact, states: whether or not [the claimed invention] has been made previously is not essential to a determination that a method of preparing it would have been known by, or would have been obvious to, one of ordinary skill in the art. 571 F.2d at 563 n.6, 197 USPQ at 4 n.6. Therefore, the statements in *In re Samour* and *Donohue I* that the claimed invention was made previously serve to point out the absence of any strong evidence of nonenablement as in *Wiggins* and *Sheppard*. See *In re Donohue*, 642 F.2d at 126 n.6, 207 USPQ at 199 n.6.

At oral argument, appellant also challenged the correctness of the CCPA's holding in *In re Samour* and *Donohue I* that several references can be used together to support an anticipation rejection. However, we are bound by the CCPA's decision in those cases. *South Corp. v. United States*, 690 F.2d 1368, 1370-71, 215 USPQ 657, 658 (Fed. Cir. 1982). At the same time, we have no difficulty with the rejections made in *In re Samour* and *Donohue I*.

[3] It is elementary that an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice, or device. E.g., *Dalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 104 S.Ct. 1284, 224 USPQ 520 (1984). The anticipation rejection used here, as in *In re Samour* and *Donohue I*, is not

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inconsistent with this rule. See *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (CCPA 1978). The additional references utilized in this case (viz., Lincoln and Wagner) are not relief upon for suggestion or motivation to combine teachings to meet the claim limitations, as in rejections under 35 U.S.C. §103. *In re Samour*, 571 F.2d at 563, 197 USPQ at 4-5. Such reliance would be pointless, because Nomura alone discloses every element claimed. The purpose of citing Lincoln and Wagner is, instead, to show that the claimed subject matter, as disclosed in Nomura, was in the public's possession. *Id.* Therefore, the anticipation rejection based on Nomura, Lincoln, and Wagner is proper. 8

Appellant also argues that the references fail to teach the solubility characteristics and melting point range set forth in dependent claims 25 and 28, respectively. 9 However, where, as here, the dicarboxylic acid TMBP and dimethyl ester TMBP of Nomura are identical to the claimed invention, the properties of Nomura's compounds are inherently the same as those of the claimed invention in the absence of proof to the contrary. See *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

In view of the foregoing, the board's decision is affirmed.

AFFIRMED

Footnotes

Footnote 1. In application Serial No. 263,900, filed May 15, 1981, for Tetramethylbiphenylcarboxylic Acids and Derivatives Thereof, which is a division of Serial No. 60,909, filed July 26, 1979, and a continuation of Serial No. 622,649, filed October 15, 1975, which is a continuation-in-part of Serial No. 517,506, filed October 24, 1974.

Footnote 2. *Donohue I* involved application No. 622,649. See note 1, *supra*.

Footnote 3. Yujiro Nomura and Yoshito Takeuchi, "Substituent Effects in Aromatic Proton Nuclear Magnetic Resonance Spectra. Part VI. [²H₆] Benzene-induced Solvent Shifts in 4,4'-Disubstituted 2,2',6,6'-

Tetramethylbiphenyls and Related Compounds," *J. Chem. Soc'y (B)*, 956-60 (1970).

Footnote 4. U.S. Patent No. 3,876,691, issued April 8, 1975, on application No. 351,696, filed April 16, 1973, for a "Process for the Hydrolysis of Nitriles."

Footnote 5. Wagner et al., *Synthetic Organic Chemistry* 412-15 (John Wiley & Sons, N.Y., N.Y.) (1965).

Footnote 6. Claim 1 in *Donohue I* differs from claim 1 of the present appeal only in that the latter includes the limitation "comprising said acid, an acyl halide derivative thereof, or a simple ester thereof." Claims 5, 6, and 7 of *Donohue I* specify the same dependent features as in the presently-appealed claims of the same number.

Footnote 7. This rule is based on the "described in a printed publication" language in 35 U.S.C. § 102(b). *See In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 371 (CCPA 1962).

Footnote 8. *Compare Studiengesellschaft Kohle, M.B.H. v. Dart Industries, Inc.*, 726 F.2d 724, 220 USPQ 841 (Fed. Cir. 1984) (recognized exception occasionally permitting use of additional references in anticipation rejections but holding exception did not apply).

Footnote 9. Claims 25 and 28 read as follows:

- . The acid of Claim 2, said acid being soluble in ether and N-Methyl-2-pyrrolidone.
- . the dimethyl ester of Claim 7, having a melting point of 128-129°C.

Footnote *. Judge Miller assumed senior status effective June 6, 1985.

- End of Case -

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